

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of reasons that follow.

Status of Claims:

No claims are currently being added or canceled.

Claims 1, 7, 8, 17, 20 and 23 are currently being amended.

This amendment and reply amends claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-5, 7, 8, 13, 15, 17, 18, 20, 21, 23, 24 and 26-32 are pending in this application.

Note on Differences In Claim Language Between this Response and Non-Entered After-final Response:

It is noted that the non-entered after-final response, which was filed on March 23, 2009, resulted in an Advisory Action dated April 13, 2009, in which the claim amendments resulted in new issues that would require further consideration and/or search. Please note that the amendments made to the independent claims by way of this ‘amendment and reply accompanying RCE’ are slightly different from the amendments made in the non-entered after-final response filed on March 23, 2009, whereby these claims are still believed to patentably distinguish over the cited art of record, as explained in detail below.

Claim Rejections – Prior Art:

In the final Office Action, claims 1-4, 7, 8, 14, 16, 17, 20, 22, 23, 28 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,377,804 to Lintulampi in view of U.S. Patent No. 6,424,638 to Ray; claims 5 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lintulampi in view of Ray and further in view of U.S. Patent No. 6,556,820 to Le et al.; claims 13, 15, 18, 19, 21, 24 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lintulampi in view of Ray and further in view of U.S. Patent Publication No. 2001/0046863 to Rinne; claims 27 and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lintulampi in view of Ray and further in

view of U.S. Patent No. 6,216,004 to Tiedmann, Jr. et al.; and claim 29 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lintulampi in view of Ray and further in view of U.S. Patent No. 7,200,110 to Burns. These rejections are traversed with respect to the presently pending claims under rejection, for at least the reasons given below.

The invention according to claim 1 is directed to a method of establishing UMTS communication between a User Equipment (UE) and a Universal Mobile Telecommunications System (UMTS) network, in which UTRAN parameters are forwarded to the UE via a GSM-type network, and in which the UTRAN parameters comprise a list of at least one access node. The claimed UTRAN parameter that comprise a list of at least one access node, which are forwarded to the UE via the GSM-type network, are not disclosed, taught or suggested by Lintulampi.

The final Office Action recognizes this deficiency in Lintulampi, and relies on Ray for providing the missing teachings in Lintulampi. In particular, the Office Action asserts that column 5, lines 32-67 of Ray teaches a list of at least one node, and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Ray into the system of Lintulampi in order to provide a handover of a call between different types of systems as Ray suggests. Ray does not disclose, teach or suggest that UTRAN parameters are forwarded to the UE, wherein those UTRAN parameters comprise a list of at least one access node, as explicitly recited in independent claim 1.

In particular, claim 1 now explicitly recites: in the UE, using the list (of at least one access node) to switch communications with the UE from the GSM-type network to the UMTS network. Certainly, Ray may disclose a “list” of access nodes. However, Ray and the presently pending claims are must different in the use of the “list”. Specifically, the “list” of Ray is a list in order that an MSC identifies a BS to be connected, and is not a list of access nodes used in the UE. Even if the teaching of Ray was combined with the system of Lintulampi, the list as taught by Ray is not used in a user equipment (e.g., a mobile station). If anything, the list of Ray is only used in any of a “GSM-op:GSM-CN” and a “UMTS-op:GSM-CN” of Lintulampi, which corresponds to the MSC of Ray. Accordingly, the list as specifically recited in claim 1 is quite different than that list of Ray, and certainly the use of

the list as specifically recited in claim 1 is not taught or suggested by the combination of Lintulampi and Ray.

Column 5, lines 32-67 of Ray describes that identity information can be used instead of location information for each base station, whereby the identity information includes a list of all mobile switching centers (MSCs) 14a and 14b for each type of wireless system 350 and 360 within an Internet Gatekeeper 320 area. **However, unlike the present invention as recited in claim 1 in which the UTRAN parameters that comprise a list of at least one access node is forwarded to a User Equipment (UE) via a GSM-type network, the identity information in the system of Ray is utilized by an Internet Gatekeeper 320, which is the entity that utilizes such access node information to determine which wireless system (350 or 360) to connect a call to a user equipment.** Clearly, the Internet Gatekeeper 320 of Ray is not the same as the User Equipment (UE) of claim 1, whereby the User Equipment (UE) of claim 1 is a device used by a User to make or answer a call, which is clearly not the case with Ray's Internet Gatekeeper 320, which is network device that is not accessed by a user to make or answer a call.

In addition, Ray discloses that the GSM MSC 14c received the list 355 from the Internet Gatekeeper 320 (see column 5, line 63 to column 6, line 6 and Figure 4 of Ray) and determines the identity of the associated MSC 14b by using the list 355 (see column 6, lines 22 to 24 and Figure 4 of Ray). However, Ray does not disclose, teach or suggest that the GSM MSC 14a forwards the list 355 to the MS 20a.

Accordingly, Ray does not disclose, teach or suggest that UTRAN parameters are forwarded to the UE and comprise a list of at least one access node that are used by the UE to switch communications with the UE from a GSM-type network to a UMTS network, as explicitly recited in presently pending independent claim 1. Therefore, Ray does not provide the missing teachings in Lintulampi.

On page 9 of the final Office Action, in the Response to Arguments section, it asserts that "Lintulampi already taught these recited limitations wherein the UE is a mobile phone and UTRAN parameters are forward[ed] to the UE." **However, the combination of Lintulampi and Ray would, at best, teach the sending of UTRAN parameters to a UE,**

whereby a list of at least one access node would not be sent to the UE, but rather it would be sent to an Internet Gatekeeper 320, which is not accessible by a user. The combined system of Lintulampi and Ray would not provide the list of at least one access node to the UE, since it's system is constructed such that the access node information is best handled by the Internet Gatekeeper 320, and to argue otherwise goes against the explicit disclosure of Ray.

Thus, the combination of Lintulampi and Ray would teach, at best, the sending of some UTRAN parameters to the UE, but it would not teach or suggest the sending of at least one access node to the UE, since that information would be sent to the Internet Gatekeeper, which is a better device for utilizing such information (at least based on the disclosure of Ray).

Turning now to the comments on page 10 of the final Office Action with respect to Figure 3 of Lintulampi, the selection of another mobile network when the home network is not available, falls well short of the features recited in claim 1 in which a list of at least one access node is provide to switch communications of the UE from an GSM-type network to a UMTS network. Furthermore, there is no teaching in Figure 3 of Lintulampi that an access node is selected from a list of access nodes when a home network is not available.

Presently pending independent claims 7, 8, 17, 20 and 23 recite similar features to those discussed above with respect to independent claim 1, and thus those independent claims are also patentable over the cited art of record.

The dependent claims under rejection are patentable over the cited art of record for the specific features recited in those claims, as well as due to their respective dependencies on one of the presently pending independent claims, the patentability of which is discussed above.

For example, with respect to the rejection of dependent claims 5, 27, 30 and 31 the final Office Action asserted that Tiedmann, Jr. et al. and Le et al. taught certain features recited in claims 5, 27, 30 and 31. Applicants respectfully disagree.

Dependent claim 5 recites potential links supplied in a list to the UE on which satisfactory communication is not possible are deleted from the list of available links. Le

discloses a MS which provides a list of USIM-IDs and how to manage the multiple USIM-IDs (for example, see column 11, lines 6-8 and 15-18 of Le). In column 2, lines 43-58 of Le, it discloses that USIM-IDs are used for managing multiple subscriptions. Thus, the list of USIM-IDs is a list of subscriptions of a MS, and there is no disclosure or suggestion that the UTRAN parameters comprise a list of at least one access node.

Still further, in Le et al., a MS provides a list of USIM-IDs during a Location Area Update (LAU) using a single message in the form of a LAU REQ signal that includes each of the application USIM-IDs. See column 11, lines 15-18 of Le et al. Column 13, lines 2-10 of Le al. discloses that USIMs can be individually activated/deactivated on a dynamic basis, in which a USIM-ID Add or USIM-ID Delete message is used to signal the addition or deletion of one or more USIM-IDs. This description in Le et al. says nothing about deleting potential links supplied in a list of available links to the UE on which satisfactory communication is not possible, since the adding and deleting of USIM-IDs as described in Le et al. appears to be done on an MS-selected basis with no detailed description as to the criteria used by the MS in performing that selection.

The final Office Action points to column 13, lines 2-10 of Le et al. for allegedly teaching that potential links supplied in a list to the UE on which satisfactory communication is not possible are deleted from the list of available links, but Applicants respectfully disagree. Namely, column 13, lines 2-10 of Le et al. describes that the Mobile Station (MS) can use a USIM-ID Add or USIM-ID Delete message to signal the addition or deletion of one or more USIM-IDs, whereby a USIM corresponds to a UMTS Subscriber Identity Module. There is nothing in this portion of Le et al. concerning the determination of whether satisfactory communication is made and whether or not such a determination is used as a criteria for deleting potential links on a list.

Accordingly, since Lintulampi and Ray do not rectify the above-mentioned deficiencies of Le et al., dependent claim 5 is patentable over the combination of Lintulampi, Ray and Le et al.

Dependent claims 27 and 31 recite switching directly from a mode in which the UE is in communication with a GSM base station to a UMTS diversity mode in which the UE is in

communication with a plurality of UMTS access nodes. In its rejection of claims 27 and 31, the Office Action cites column 14, lines 50-65 of Tiedemann, Jr. et al. for allegedly teachings the features recited in these claims. Applicants respectfully disagree. Namely, column 14, lines 50-65 of Tiedemann, Jr. et al. describes that if the mobile unit is in a handoff mode communicating to multiple base stations or in a cell diversity mode, the calls are routed to the appropriate base stations for transmission to the appropriate base station transmitter to the intended recipient mobile station. **However, this use of diversity communications is for a single network, and thus, at best, Tiedemann, Jr. et al. describes switching from a non-diversity mode to a diversity mode for a single network, and it does not teach or suggest switching from a non-diversity mode in a first network (GSM network) to a diversity mode in a second network (UMTS network) different from the first network.** The fact that Lintulampi describes a UMTS network and a GSM network does not change the fact that Tiedemann, Jr. only describes changing a diversity mode in a single network, since to argue otherwise would be reading much too much into Tiedemann, Jr., whereby the switching from a non-diversity mode in one network to a diversity mode in another network goes well beyond the teachings of Tiedemann, Jr., and the combination of Tiedemann, Jr. and Lintulampi would not result in such a complicated diversity system that probably would not work in such a combined system.

Since none of the other cited art of record rectifies these deficiencies of Tiedemann, Jr. et al., dependent claims 27 and 31 are patentable over the cited art of record.

Dependent claim 30 recites that the UTRAN parameter information output from the UMTS network tunnels through the GSM-type network without being interpreted or processed in any manner by the GSM-type network. As seen in Figures 4a, 4b, 5a and 5b of Lintulampi, on the other hand, the GSM components do appear to interpret and/or process signals sent between the MS and the UMTS network. See, for example, steps 3, 4 and 5 in Figures 4a and 4b of Lintulampi. The Office Action recognizes this deficiency of Lintulampi, and points to Figure 8, element 810 of Le et al. for allegedly teaching this feature. However, element 810 in Figure 8 of Le et al. merely is an Iu interface between a 3G MSC/VLR and an RNC, whereby there is no teaching or suggestion that the 3G MSC/VLR and the 3G SGSN

components of the GSM network do not process UTRAN parameter information that may or may not pass through the Iu interface 810.

Conclusion:

Since all of the issues raised in the final Office Action have been addressed in this Reply, Applicants believe that the present application is now in condition for allowance, and an early indication of allowance is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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